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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/355,635	08/02/99	CONROY	72005-7

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IM22/0911

EXAMINER
MIGGINS, M

ART UNIT
1772

PAPER NUMBER
6

DATE MAILED: 09/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/355,635

Applicant(s)

CONROY ET AL.

Examiner

Michael C. Miggins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-19, drawn to a method of protecting a surface from corrosion, classified in class 427, subclass 403.

II. Claims 20-29, drawn to a cementitious composition, classified in class 524, subclass 650.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as building material such as a sidewalk, bridge, barrier wall. See MPEP § 806.05(d).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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6. During a telephone conversation with Richard Tushin on 6/4/01 a provisional election was made with traverse to prosecute the invention of II, claims 20-29.

Affirmation of this election must be made by applicant in replying to this Office action.

Claims 1-19 are withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim 22 recites the limitation "10 parts by weight pozzolan" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

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11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 20-21, 23-25 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Heitzmann et al. (WO 89/02878).

Heitzmann et al. teach a cementitious composition comprising at least one cement in combination with metakaolin, comprising not more than 30 parts by weight metakaolin, further comprising a cement replacement material in an amount of not more than 70 parts by weight, based on the dry composition, wherein the cement replacement material is ground granulated blast furnace slag and/or pulverized fuel ash and sand (abstract, page 3 and examples 1-2) (applies to instant claims 20-21, 23-25 and 28).

Claim Rejections - 35 USC § 103

13. Claims 20-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heitzmann et al. (WO 89/02878) in view of Allen et al. (WO 95/11863).

Heitzmann et al. teach a cementitious composition comprising at least one cement in combination with metakaolin, comprising not more than 30 parts by weight metakaolin, further comprising a cement replacement material in an amount of not more than 70 parts by weight, based on the dry composition, wherein the cement replacement material is ground granulated blast furnace slag and/or pulverized fuel ash

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and sand (abstract, page 3 and examples 1-2) (applies to instant claims 20-21, 23-25 and 28).

Heitzmann et al. disclose applicant's invention substantially as claimed.

However, Heitzmann et al. fail to teach the claimed composition further comprising aggregate and/or fibre reinforcement and a pipe comprising a hollow metallic conduit and coating provided on an internal and/or external surface to the conduit, wherein the coating comprises applicant's claimed composition.

Allen et al. teach a cementitious composition composition further comprising aggregate and/or fibre reinforcement and a pipe comprising a hollow metallic conduit and coating provided on an internal and/or external surface to the conduit, wherein the coating comprises said cementitious composition made from Portland cement for the purpose of providing improved cracking resistance (abstract, page 1, lines 20-25, page 3) (applies to instant claims 26 and 29).

Therefore it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided aggregate and/or fibre reinforcement and a pipe comprising a hollow metallic conduit and coating provided on an internal and/or external surface to the conduit in the cementitious composition of Heitzmann et al. in order to provide improved cracking resistance as taught by Allen et al..

The combined teachings of Heitzmann et al. and Allen et al. disclose the claimed invention except for the parts pozzolan and parts water recited in the claims 22 and 27. Achieving the claimed parts pozzolan and parts water would have been routine

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optimization of a result effective variable. *In re Aller*, 105 USPQ 233 and *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

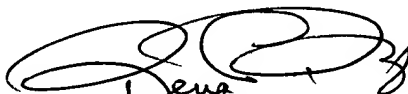
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Miggins whose telephone number is (703) 305-0915. The examiner can normally be reached on Monday-Friday; 1:30-10:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dye Rena can be reached on (703) 308-4331. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7718 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

MCM *MCM*
September 10, 2001


RENA L. DYE
PRIMARY EXAMINER
Tech Center 1700